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116

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/634,195 08/09/00 CROWTHER

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EXAMINER

IM52/1107

UNIVATION TECHNOLOGIES
SUITE 1950
5555 SAN FELIPE
HOUSTON TX 77056

PASTERCZYK, J

ART UNIT

PAPER NUMBER

1755

DATE MAILED:

11/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/634,195

Applicant(s)
Crowther

Examiner
J. Pasterczyk

Art Unit
1755



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 20, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above, claim(s) 28-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

Art Unit: 1755

1. This Office action is in response to the election of 8/20/01.
2. Applicant's election with traverse of claims 1-27 and 32-33 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that there would be no burden searching the other invention. This is not found persuasive because the other invention is classified in a separate class in multiple subclasses.

The requirement is still deemed proper and is therefore made FINAL.

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-27, drawn to an olefin polymerization catalyst, classified in class 502, subclass 117.
- II. Claims 32-33, drawn to a compound, classified in class 556, subclass various depending on the particulars of the compound.

4. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a UV visible light filter pigment, and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be

Art Unit: 1755

obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Lisa Kimes Jones, Esq., on 11/01/01, a provisional election was made with traverse to prosecute the invention of group I, claims 1-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 32-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Claims 1-27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed contains no description of the metal being from group 9.

8. Claims 1-27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Many of the transition metal compounds of claim 1 would be formally

Art Unit: 1755

electron deficient, the early metal ones highly so, so that the formula given would not likely represent the actual structural formula of the compound made. Conversely, many of the late transition metal compounds of claim 1 would be highly electron rich, possibly violating the 18 electron rule, and thus would not likely be stable if obtainable. Finally, many of the compounds of the formula in claim 1 would likely have an odd number of electrons and thus be paramagnetic, thus also being likely highly reactive and not stable in the formula given or possibly dimeric in structure. Beyond the two specific examples given in the specification, it is not clear that the universe of compounds described by the formula of claim 1 would exist; overbroad claiming results in enablement problems. In addition, it is widely known that cyclopropenyl rings are highly strained and thus likely to insert into something else, making e.g. a metallocyclobutene. There does not appear to be any clear physical evidence that the cyclopropenyl rings of the present claims exist as such in the neutral transition metal compounds. Such data may be e.g. proton or ^{13}C NMR data showing that all three positions on the rings are equivalent on the NMR time scale, indicating that the ring is spinning rapidly, hence making all the positions equivalent.

9. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, l. 2, change "exposure" to --contact-- since exposure may imply merely having separate beakers containing the two reagents in the same room together. In l. 3, change "may be"

Art Unit: 1755

to --is-- for definiteness. In the third from last line, it is not clear what is meant by "cyclopentadienyl-derived".

In claims 2-4, second line of each, change "may be" to --is-- for definiteness.

In claim 26, if the metal were scandium, the formula given in claim 2 could not be obtained since the maximum oxidation state for scandium is 3+.

10. The claims appear to be allowable over the prior art. However, due to the formal rejections, in particular the question of whether the compounds formed actually conform to the formulae in the claims, the patentability of the claims is not yet clear.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is (703) 308-3497. The examiner can normally be reached on M-F from 8:30 to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703) 308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5433.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



J. Pasterczyk

11/02/01



Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700